

Remarks

The Office Action mailed June 2, 2004 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

The Remarks section of the Office Action indicates that a signed copy of the Form PTO-1449 was not provided because the IDS is missing. Applicants traverse the assertion that an IDS was not provided in this case. More specifically, Applicants submit that an IDS was provided in this case on November 20, 2001. Submitted herewith is a copy of the IDS with attachments that was mailed to the PTO on November 20, 2001.

Claims 1-5 and 7-118 are pending in this application. Claims 1-118 stand rejected. Claim 6 has been canceled.

In accordance with 37 C.F.R. 1.136(a), a one month extension of time is submitted herewith to extend the due date of the response to the Office Action dated June 2, 2004, for the above-identified patent application from September 2, 2004, through and including October 4, 2004. In accordance with 37 C.F.R. 1.17(a)(3), authorization to charge a deposit account in the amount of \$110.00 to cover this extension of time request also is submitted herewith.

The Office Action asserts that the specification is objected to “because the phrase ‘software management sigma value’ is not defined.” Applicants respectfully traverse this assertion. Specifically, Applicants respectfully submit that the term “software management sigma value” is clearly defined in the specification at, for example, page 15, line 33 to page 16, line 2, which provides that compliance to the overall software management process based on the response to the self-assessment is computed in terms of “Software Management Sigma Value”. In addition and by way of further example, page 16, line 4 to page 18, line 29 describes the information used to compute the Software Management Sigma Value. Therefore, Applicants respectfully submit that the specification, including the figures, would enable one skilled in the art to make and/or use the invention as described in the present patent application. Accordingly, Applicants respectfully submit that the specification request that the objections to the specification be withdrawn.

With respect to the assertion in the Office Action of using the terms “software management sigma value” and “sigma value” interchangeably, Applicants submit that the claims have been amended to address this objection.

The objection to Claims 10 and 18-23 for certain informalities is respectfully traversed. Claims 10 and 18 have been amended to address this objection. Accordingly, Applicants respectfully submit that the objection to Claims 10 and 18-23 for certain informalities be withdrawn.

The rejection of Claims 10, 35-36, 48 and 49 under 35 U.S.C. § 112, first paragraph, is respectfully traversed.

Applicants respectfully submit that the specification meets the requirements of Section 112, first paragraph. Specifically, Applicants respectfully submit that the specification, including the figures, would enable one skilled in the art to make and/or use the invention as described in the present patent application. Accordingly, Applicants respectfully request that the rejection of Claims 10, 35-36, 48 and 49 under Section 112, first paragraph, be withdrawn.

The Office Action indicates at page 3 that the “claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” More specifically, the Office Action indicates that the specification “neither provides a definition of ‘sigma value’, nor actual method steps for computation of said value.”

Applicants respectfully traverse these assertions, and submit that the term “sigma value” is clearly defined in the specification at, for example, page 15, line 33 to page 16, line 2, which provides that compliance to the overall software management process based on the response to the self-assessment is computed in terms of “Software Management Sigma Value”. In addition and by way of further example, page 16, line 4 to page 18, line 29 describes the information used to compute the Software Management Sigma Value. Specifically, Figures 13 and 14 show a set of specific questions relating to the management of software assets. These questions are responded to by a user as part of a self-assessment. The responses are then used to compute the

Software Management Sigma Value. Applicants therefore respectfully submit that the specification, including the figures, would enable one skilled in the art to make and/or use the invention as described in the present patent application including calculating the Software Management Sigma Value. Accordingly, Applicants respectfully request that the rejection of Claims 10, 35-36, 48 and 49 under Section 112, first paragraph, be withdrawn.

For the reasons set forth above, Applicants respectfully request that the rejection of Claims 10, 35-36, 48 and 49 under Section 112, first paragraph, be withdrawn.

The rejection of Claims 1-46 and 50-113 under 35 U.S.C. § 112, second paragraph, is respectfully traversed.

Applicants respectfully submit that Claims 1-46 and 50-113 satisfy section 112, second paragraph. More specifically, Applicants respectfully submit that Claims 1-46 and 50-113 are definite and particularly point out and distinctly claim the subject matter of the invention. However, in an effort to expedite the prosecution of this patent application, Claims 1, 4-5, 7-8, 10, 22 and 50 have been amended to address the rejections raised herein. Claim 6 has been canceled. Accordingly, Applicants respectfully request that the rejection of Claims 1-46 and 50-113 under Section 112, second paragraph, be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the rejection of Claims 1-46 and 50-113 under 35 U.S.C. § 112, second paragraph, be withdrawn.

The rejection of Claims 1-49 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is respectfully traversed.

The Office Action suggests at pages 3 and 4 that method Claims 1-49 are rejected under Section 101 because “the claimed method for managing software assets does not recite a limitation in the technological arts.” Thus, Claims 1-49 are rejected as being directed to non-statutory subject matter. Applicants respectfully traverse this suggestion. However, Applicants have amended independent Claims 1, 47, 48 and 49 to address the rejection set forth in the Office Action for Claims 1-49.

With respect to Claims 1, Applicants submit that the claims of the present patent application are directed to practical applications in the technological arts. “Any sequence of operational steps can constitute a process within the meaning of the Patent Act so long as it is part of the technological arts.” *In re Musgrave*, 431 F.2d 882 (C.C.P.A. 1970). For example, independent Claim 1 is a method for managing software assets of a business entity using a web-based system including a server system coupled to a centralized database and at least one client system. Applicants submit that managing software assets is a useful process that is considered to be within “the technological arts”.

One specific example of such a method implementation is a computer with a processor programmed to at least one of identify at least one software asset satisfying a predetermined requirement of the business entity, initiate and complete an acquisition process of the at least one software asset satisfying the predetermined business requirement, deploy the acquired software asset, store in a database information relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license, maintain each software asset licensed by the business entity, retire a software asset when the software asset is no longer required by the business entity, and audit each software asset owned or licensed by the business entity. While the claims are not limited to the specific examples related to a computer with a programmed processor, the claims need not be so restricted to satisfy the requirement of Section 101.

Applicants further traverse the assertion included in the Office Action that Claims 1-49 are directed to non-statutory subject matter under Section 101 in light of the “Examination Guidelines for Computer-Related Inventions”. The Examination Guidelines for Computer-Related Inventions provides in relevant part as follows:

In order to determine whether the claim is limited to a practical application of an abstract idea, Office personnel must analyze the claim as a whole, in light of the specification, to understand what subject matter is being manipulated and how it is being manipulated. During this procedure, Office personnel must evaluate any statements of intended use or field of use, any data gathering step and any post-manipulation activity....Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under § 101.

Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.

Applicants respectfully submit that Claim 1 is limited to a practical application in the technological arts. Furthermore, Applicants respectfully submit that the Office Action does not expressly state how the language of Claim 1 supports the Section 101 rejection.

Claim 1 has been amended. Claim 1 recites a “method for managing software assets of a business entity”. Thus, Applicants submit that Claim 1 is directed to a useful process that is considered to be within “the technological arts”. Furthermore, Claim 1 recites “a method for managing software assets of a business entity using a web-based system including a server system coupled to a centralized database and at least one client system”. The method includes “storing in the centralized database information relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license...and auditing each software asset owned or licensed by the business entity by prompting a user to respond to at least one question relating to the corresponding software asset uploaded from the server system to the client system for quantifying compliance with the software management process of the business entity.” Thus, Claim 1 uses a computer system to perform certain steps of the process. Claim 1 is therefore directed to a practical application in the technological arts.

Dependent Claims 2-5 and 7-46 depend from independent Claim 1, and these dependent Claims are submitted to satisfy the requirements of Section 101 for the same reasons set forth above with respect to independent Claim 1.

With respect to Claims 47-49, Applicants respectfully submit that Claims 47-49 are directed to practical applications in the technological arts for the same reasons set forth above. Accordingly, Applicants respectfully submit that Claims 47-49 satisfy the requirements of Section 101.

For at least the reasons set forth above, Applicants respectfully request that the Section 101 rejection of Claims 1-49 be withdrawn.

The rejection of Claims 1-6, 8, 11-12, 14-17, 19, 24-25, 28, 38-40, 42-43 and 114-118 under 35 U.S.C. § 102 as being unpatentable over Conte et al. (U.S. Patent No. 5,845,065) (“Conte”) is respectfully traversed. Moreover, Applicants note that the Office Action does not specifically reject Claims 44-113 under 35 U.S.C. § 102 as being unpatentable over Conte. However, the Office Action asserts at pages 5 and 6-9 that at least some of Claims 44-113 are unpatentable over Conte. As such, Applicants respectfully traverse the rejection of any of Claims 44-113 as being unpatentable over Conte.

Applicants respectfully submit that Conte does not describe or suggest the claimed invention. As discussed below, at least one of the differences between Conte and the present invention is that Conte does not describe or suggest a method for managing software assets of a business entity having a software management process, wherein the method includes identifying at least one software asset satisfying a predetermined requirement of the business entity, initiating and completing an acquisition process of the at least one software asset satisfying the predetermined business requirement, deploying the acquired software asset, and storing in a centralized database information relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license.

Moreover, Conte does not describe or suggest maintaining software assets licensed by a business entity including reviewing each software license and installing updated software when provided by the software license, and retiring a software asset when the software asset is no longer required by the business entity.

Furthermore, Conte does not describe or suggest auditing software assets owned or licensed by a business entity by prompting a user to respond to at least one question relating to the corresponding software asset uploaded from a server system to a client system for quantifying compliance with a software management process of the business entity.

Conte describes a license compliance apparatus for controlling operation of remote networked devices, such as computers, in compliance with licensed restrictions. The license restrictions allow access to a predetermined number of users to a specific application. The license compliance apparatus determines whether a distribution exists which would result in

access to the specific application for the requesting user and all current users. In one embodiment, licenses are assigned to users in the order of application requests that are made. When a request is made and no licenses are available, an analysis is performed to determine whether licenses may be swapped in such a fashion so as to free up a license for the requested application.

Claim 1 recites a method for managing software assets of a business entity using a web-based system including a server system coupled to a centralized database and at least one client system, the business entity having a software management process, wherein the method includes “identifying at least one software asset satisfying a predetermined requirement of the business entity...initiating and completing an acquisition process of the at least one software asset satisfying the predetermined business requirement...deploying the acquired software asset...storing in the centralized database information relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license...maintaining each software asset licensed by the business entity including reviewing each software license and installing updated software when provided by the software license...retiring a software asset when the software asset is no longer required by the business entity...auditing each software asset owned or licensed by the business entity by prompting a user to respond to at least one question relating to the corresponding software asset uploaded from the server system to the client system for quantifying compliance with the software management process of the business entity.”

Conte does not describe or suggest a method for managing software assets of a business entity using a web-based system as recited in Claim 1. More specifically, Conte does not describe or suggest a method that includes identifying at least one software asset satisfying a predetermined requirement of the business entity, initiating and completing an acquisition process of the at least one software asset satisfying the predetermined business requirement, deploying the acquired software asset, and storing in a centralized database information relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license.

Moreover, Conte does not describe or suggest maintaining software assets licensed by a business entity including reviewing each software license and installing updated software when provided by the software license, and retiring a software asset when the software asset is no longer required by the business entity.

Furthermore, Conte does not describe or suggest auditing software assets owned or licensed by a business entity by prompting a user to respond to at least one question relating to the corresponding software asset uploaded from a server system to a client system for quantifying compliance with a software management process of the business entity.

Rather, Conte describes a license compliance apparatus for allowing access to a requesting user to a specific application by determining whether a distribution exists which would result in access to the specific application for the requesting user and all current users. Specifically, in Conte, an analysis is performed by the license compliance apparatus to determine whether licenses may be swapped in such a fashion so as to free up a license for the requested application. As such, Conte does not describe or suggest maintaining software assets by reviewing each software license and installing updated software when provided by the software license, retiring a software asset when the software asset is no longer required by the business entity, and auditing software assets by prompting a user to respond to at least one question relating to the corresponding software asset uploaded from a server system to a client system for quantifying compliance with a software management process of the business entity. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over Conte.

Claims 2-6, 8, 11-12, 14-17, 19, 24-25, 28, 38-40 and 42-43 depend from independent Claim 1. When the recitations of Claims 2-6, 8, 11-12, 14-17, 19, 24-25, 28, 38-40 and 42-43 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-6, 8, 11-12, 14-17, 19, 24-25, 28, 38-40 and 42-43 likewise are patentable over Conte.

Claim 50 recites a web-based system for managing software assets of a business entity, the business entity having a software management process, the system includes a client system, a centralized database, and a server system configured “to be coupled to said client system and

said centralized database, said server system further configured to identify at least one software asset satisfying a predetermined requirement of the business entity...initiate and complete an acquisition process of the at least one software asset satisfying the predetermined business requirement...prompt a user to deploy the acquired software asset...store in the database information relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license...maintain each software asset licensed by the business entity including prompting the user to review each software license and install updated software as provided by the software license...prompt the user to retire a software asset when the software asset is no longer required by the business entity...audit each software asset owned or licensed by the business entity by prompting the user to respond to at least one question displayed on the client system relating to the corresponding software asset for quantifying compliance with the software management process of the business entity.”

Conte does not describe or suggest a web-based system for managing software assets of a business entity as recited in Claim 50. More specifically, Conte does not describe or suggest a web-based system that includes a server system configured to identify at least one software asset satisfying a predetermined requirement of the business entity, initiate and complete an acquisition process of the at least one software asset satisfying the predetermined business requirement, prompt a user to deploy the acquired software asset, and store in a database information relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license.

Moreover, Conte does not describe or suggest a server system configured to maintain each software asset licensed by a business entity including prompting a user to review each software license and install updated software as provided by the software license, and prompt the user to retire a software asset when the software asset is no longer required by the business entity.

Furthermore, Conte does not describe or suggest a server system configured to audit each software asset owned or licensed by a business entity by prompting a user to respond to at least

one question displayed on the client system relating to the corresponding software asset for quantifying compliance with the software management process of the business entity.

Rather, Conte describes a license compliance apparatus for allowing access to a requesting user to a specific application by determining whether a distribution exists which would result in access to the specific application for the requesting user and all current users. Specifically, an analysis is performed by the license compliance apparatus to determine whether licenses may be swapped in such a fashion so as to free up a license for the requested application. Conte does not describe or suggest a system as recited in Claim 50.

Furthermore, the Office Action asserts that Claim 50 recites “non-functional language” and are “given no patentable weight.” Additionally, the Office Action asserts that claims “directed to an apparatus must be distinguished from the prior art in terms of structure rather than function” and “a claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim.” (See Office Action dated June 2, 2004, page 5, paragraphs 3 and 4).

Applicants, however, respectfully submit that these assertions are contrary to controlling law. A patent applicant is free to recite features of an apparatus either structurally or functionally. In re Schreiber, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); In re Swinheart, 169 USPQ 226, 228 (CCPA 1971). In determining anticipation of a patent claim, it is improper to disregard the preamble and functional limitations, including recitations such as “adapted to”, “whereby”, and “thereby”. Pac-Tec, Inc. v. Amerace Corp., 14 USPQ2d 1871, 1876 (Fed. Cir. 1990); and In re Venezia, 189 USPQ 149 (CCPA 1976).

Moreover, Applicants submit that the recitation included in amended Claim 50 of “said server system further configured to identify at least one software asset satisfying a predetermined requirement of the business entity...initiate and complete an acquisition process of the at least one software asset satisfying the predetermined business requirement...prompt a user to deploy the acquired software asset...store in the database information relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding

software license...maintain each software asset licensed by the business entity including prompting the user to review each software license and install updated software as provided by the software license...prompt the user to retire a software asset when the software asset is no longer required by the business entity...audit each software asset owned or licensed by the business entity by prompting the user to respond to at least one question displayed on the client system relating to the corresponding software asset for quantifying compliance with the software management process of the business entity” is structural language. In other words, the server system described in the present application is structurally configured to perform as recited in Claim 50. Therefore, this recitation is entitled to full patentable weight and should be fully considered by the Patent Office.

As stated above, Conte neither describes nor suggests a system as recited in Claim 50. Accordingly, Applicants respectfully submit that Claim 50 is patentable over Conte.

Claims 51-113 depend from independent Claim 1. When the recitations of Claims 51-113 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 51-113 likewise are patentable over Conte.

Claim 114 recites a software license management system to automate a software management process for managing software assets of a business entity, measuring compliance requirements, and tracking/reporting status as necessary to assure proficiency and adherence to implementation requirements of the software management process, the system includes a client system, a centralized database, a server system configured to be coupled to the client system and the database, wherein the server system is configured to “organize and process information using at least one of an a software identification module, an acquisition module, a deployment module, a maintenance module and a software retirement module...prompt a user to respond to a plurality of questions relating to a software asset of the business entity by displaying the questions on the client system...compute a sigma value based on the user’s responses to the plurality of questions to measure compliance with the software management process...provide feedback and suggestions based on the computed sigma value to help reduce the exposure to litigation and

penalties, maximize software asset utilization through tighter inventory control, and capitalize on the software procurement process.”

Conte does not describe or suggest a software license management system as recited in Claim 114. More specifically, Conte does not describe or suggest a server system configured to organize and process information using at least one of a software identification module, an acquisition module, a deployment module, a maintenance module and a software retirement module, and prompt a user to respond to a plurality of questions relating to a software asset of the business entity by displaying the questions on a client system.

Moreover, Conte does not describe or suggest a server system configured to compute a sigma value based on a user’s responses to a plurality of questions to measure compliance with a software management process, and provide feedback and suggestions based on the computed sigma value to help reduce the exposure to litigation and penalties, maximize software asset utilization through tighter inventory control, and capitalize on the software procurement process.

Rather, Conte describes a license compliance apparatus for allowing access to a requesting user to a specific application by determining whether a distribution exists which would result in access to the specific application for the requesting user and all current users. Specifically, an analysis is performed by the license compliance apparatus to determine whether licenses may be swapped in such a fashion so as to free up a license for the requested application. Accordingly, Conte does not describe or suggest a software license management system as recited in Claim 114.

Claim 115 recites a system for tracking software assets owned and licensed by a business entity, the business entity having a software management process, the system includes a client system, a centralized database, a server system configured to be coupled to the client system and the database, wherein the server system is configured to “access the centralized database containing software assets information including data relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license...search the database regarding a specific inquiry received from a user...retrieve information from the database...cause the retrieved information to be displayed for tracking,

monitoring and auditing purposes...audit each software asset owned or licensed by the business entity by prompting a user to respond to at least one question displayed on the client system relating to the corresponding software asset for quantifying compliance with the software management process of the business entity.”

Conte does not describe or suggest a system for tracking software assets owned and licensed by a business entity as recited in Claim 115. More specifically, Conte does not describe or suggest a server system configured to access a centralized database containing software assets information including data relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license, search the database regarding a specific inquiry received from a user, retrieve information from the database, and cause the retrieved information to be displayed for tracking, monitoring and auditing purposes.

Moreover, Conte does not describe or suggest a server system configured to audit each software asset owned or licensed by a business entity by prompting a user to respond to at least one question displayed on a client system relating to a corresponding software asset for quantifying compliance with a software management process of the business entity.

Rather, Conte describes a license compliance apparatus for allowing access to a requesting user to a specific application by determining whether a distribution exists which would result in access to the specific application for the requesting user and all current users. Specifically, an analysis is performed by the license compliance apparatus to determine whether licenses may be swapped in such a fashion so as to free up a license for the requested application. Accordingly, Conte does not describe or suggest a system for tracking software assets owned and licensed by a business entity as recited in Claim 115.

Claim 116 recites a system for tracking software assets owned and licensed by a business entity, the business entity having a software management process, the system includes a client system, a centralized database, a server system configured to be coupled to the client system and the database, wherein the server system is configured to “display on the client system for a user a software management assessment checklist including a series of questions relating to a software asset owned or licensed by the business entity...receive responses entered by the user through

the client system to each question included within the software management assessment check list...compute a sigma value based on guidelines pre-stored within the database, wherein the sigma value indicates compliance with the software management process of the business entity.”

Conte does not describe or suggest a system for tracking software assets owned and licensed by a business entity as recited in Claim 116. More specifically, Conte does not describe or suggest a server system configured to display on a client system for a user a software management assessment checklist including a series of questions relating to a software asset owned or licensed by the business entity, and receive responses entered by the user through the client system to each question included within the software management assessment check list.

Moreover, Conte does not describe or suggest a server system configured to compute a sigma value based on guidelines pre-stored within a database, wherein the sigma value indicates compliance with a software management process of a business entity.

Rather, Conte describes a license compliance apparatus for allowing access to a requesting user to a specific application by determining whether a distribution exists which would result in access to the specific application for the requesting user and all current users. Specifically, an analysis is performed by the license compliance apparatus to determine whether licenses may be swapped in such a fashion so as to free up a license for the requested application. Accordingly, Conte does not describe or suggest a system for tracking software assets owned and licensed by a business entity as recited in Claim 116.

Claim 117 recites a system for tracking software assets owned and licensed by a business entity, the business entity having a software management process, the system includes a client system, a centralized database, a server system configured to be coupled to the client system and the centralized database, wherein the server system is configured to “receive user input in response to specific questions relating to a software asset owned or licensed by the business entity...analyze user input against a pre-determined criteria...output a sigma value based on the user input and the pre-determined criteria, wherein the sigma value indicates compliance with the software management process of the business entity.”

Conte does not describe or suggest a system for tracking software assets owned and licensed by a business entity as recited in Claim 117. More specifically, Conte does not describe or suggest a server system configured to receive user input in response to specific questions relating to a software asset owned or licensed by the business entity, analyze user input against a pre-determined criteria, and output a sigma value based on the user input and the pre-determined criteria wherein the sigma value indicates compliance with a software management process of the business entity.

Rather, Conte describes a license compliance apparatus for allowing access to a requesting user to a specific application by determining whether a distribution exists which would result in access to the specific application for the requesting user and all current users. Specifically, an analysis is performed by the license compliance apparatus to determine whether licenses may be swapped in such a fashion so as to free up a license for the requested application. Accordingly, Conte does not describe or suggest a system for tracking software assets owned and licensed by a business entity as recited in Claim 117.

Claim 118 recites a computer system for tracking software assets owned and licensed by a business entity, the business entity having a software management process, the computer system includes a client system, a centralized database, a server system configured to be coupled to the client system and the centralized database, wherein the server system includes “a receiving component that receives and stores information from a user as well as receives a request for specific information from the user, the information received from the user including responses to specific questions relating to a software asset owned or licensed by the business entity...a processing component that processes the received information and analyzes the received information against a pre-determined range of management criteria to satisfy the user request...an information fulfillment component that downloads the requested information to the user including a sigma value indicating compliance with the software management process of the business entity.”

Conte does not describe or suggest a computer system for tracking software assets owned and licensed by a business entity as recited in Claim 118. More specifically, Conte does not

describe or suggest a server system that includes a receiving component that receives and stores information from a user as well as receives a request for specific information from the user wherein the information received from the user includes responses to specific questions relating to a software asset owned or licensed by the business entity, a processing component that processes the received information and analyzes the received information against a pre-determined range of management criteria to satisfy the user request, and an information fulfillment component that downloads the requested information to the user including a sigma value indicating compliance with the software management process of the business entity.

Rather, Conte describes a license compliance apparatus for allowing access to a requesting user to a specific application by determining whether a distribution exists which would result in access to the specific application for the requesting user and all current users. Specifically, an analysis is performed by the license compliance apparatus to determine whether licenses may be swapped in such a fashion so as to free up a license for the requested application. Accordingly, Conte does not describe or suggest a computer system for tracking software assets owned and licensed by a business entity as recited in Claim 118.

Furthermore, the Office Action asserts that each of Claims 114-118 recite “non-functional language” and are “given no patentable weight.” Additionally, the Office Action asserts that claims “directed to an apparatus must be distinguished from the prior art in terms of structure rather than function” and “a claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim.” (See Office Action dated June 02, 2004, pages 5-7).

Applicants again respectfully submit that these assertions are contrary to controlling law. A patent applicant is free to recite features of an apparatus either structurally or functionally. In re Schreiber, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); In re Swinheart, 169 USPQ 226, 228 (CCPA 1971). In determining anticipation of a patent claim, it is improper to disregard the preamble and functional limitations, including recitations such as “adapted to”, “whereby”, and

“thereby”. Pac-Tec, Inc. v. Amerace Corp., 14 USPQ2d 1871, 1876 (Fed. Cir. 1990); and In re Venezia, 189 USPQ 149 (CCPA 1976).

Moreover, Applicants submit that the recitations included in amended Claims 114-118 are structural recitations. Therefore, these recitations are entitled to full patentable weight and should be fully considered by the Patent Office. Accordingly, for at least the reasons set forth above, Claims 114-118 are submitted to be patentable over Conte.

For at least the reasons set forth above, Applicants request that the Section 102 rejection of Claims 1-6, 8, 11-12, 14-17, 19, 24-25, 28, 38-40, 42-43 and 114-118 be withdrawn.

The rejection of Claims 7, 9, 13, 26-27, 29-34, 37 and 41 under 35 U.S.C. § 103(a) as being unpatentable over Conte in view of Jacobson (U.S. Patent No. 6,735,701) is respectfully traversed.

Conte is described above. Jacobson describes a policy effectiveness system for maintaining security and use policy compliance on a computer network. The system electronically monitors network user compliance with a network security policy stored in a database, electronically evaluates network security policy compliance based on network user compliance, and electronically undertakes a network policy compliance action in response to network security policy compliance. The network policy compliance actions include electronically implementing a different network security policy selected from network security policies stored in the database, generating policy effectiveness reports, and providing a retraining module to network users.

Claims 7, 9, 13, 26-27, 29-34, 37 and 41 depend from independent Claim 1. Claim 1 recites a method for managing software assets of a business entity using a web-based system including a server system coupled to a centralized database and at least one client system, the business entity having a software management process, wherein the method includes “identifying at least one software asset satisfying a predetermined requirement of the business entity...initiating and completing an acquisition process of the at least one software asset satisfying the predetermined business requirement...deploying the acquired software

asset...storing in the centralized database information relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license...maintaining each software asset licensed by the business entity including reviewing each software license and installing updated software when provided by the software license...retiring a software asset when the software asset is no longer required by the business entity...auditing each software asset owned or licensed by the business entity by prompting a user to respond to at least one question relating to the corresponding software asset uploaded from the server system to the client system for quantifying compliance with the software management process of the business entity.”

Neither Conte nor Jacobson, considered alone or in combination, describe or suggest a method for managing software assets of a business entity as recited in Claim 1. More specifically, neither Conte nor Jacobson, considered alone or in combination, describe or suggest a method that includes identifying at least one software asset satisfying a predetermined requirement of the business entity, initiating and completing an acquisition process of the at least one software asset satisfying the predetermined business requirement, deploying the acquired software asset, and storing in a centralized database information relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license.

Moreover, neither Conte nor Jacobson, considered alone or in combination, describe or suggest maintaining software assets licensed by a business entity including reviewing each software license and installing updated software when provided by the software license, and retiring a software asset when the software asset is no longer required by the business entity.

Furthermore, neither Conte nor Jacobson, considered alone or in combination, describe or suggest auditing software assets owned or licensed by a business entity by prompting a user to respond to at least one question relating to the corresponding software asset uploaded from a server system to a client system for quantifying compliance with a software management process of the business entity.

Rather, Conte describes a license compliance apparatus for allowing access to a requesting user to a specific application by determining whether a distribution exists which would result in access to the specific application for the requesting user and all current users; and Jacobson describes a policy effectiveness system for maintaining security and use policy compliance on a computer network. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over Conte in view of Jacobson.

When the recitations of Claims 7, 9, 13, 26-27, 29-34, 37, and 41 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 7, 9, 13, 26-27, 29-34, 37, and 41 likewise are patentable over Conte in view of Jacobson.

The rejection of Claims 10 and 35-36 under 35 U.S.C. § 103(a) as being unpatentable over Conte and Jacobson in view of Hedstrom et al. (U.S. Patent No. 6,477,471) (“Hedstrom”) is respectfully traversed.

Conte and Jacobson are both described above. Hedstrom describes a statistical tool apparatus for predicting defects in products that includes a processor, a memory, a keyboard, a drive for loading a software package and a display. The processor is loaded with a program for storing historical data indicating the historical pattern of defect containment in the stages of development. The processor has stored therein algorithms for computing sigma values based on opportunities and escaping defects in the stages, and includes an algorithm for backsolving from historical data. The apparatus provides historical data of defects at different stages of development and a value representing a goal for escaping defects. The apparatus also provides the planned total number of opportunities for defects. The goal for number of escaping defects and the planned number of opportunities for defects are backsolved to determine the total number of defects. The total defects are distributed as a function of the historical data to provide prediction of defects at the different stages of development.

Claims 10 and 35-36 depend from independent Claim 1. Claim 1 recites a method for managing software assets of a business entity using a web-based system including a server system coupled to a centralized database and at least one client system, the business entity having a software management process, wherein the method includes “identifying at least one

software asset satisfying a predetermined requirement of the business entity...initiating and completing an acquisition process of the at least one software asset satisfying the predetermined business requirement...deploying the acquired software asset...storing in the centralized database information relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license...maintaining each software asset licensed by the business entity including reviewing each software license and installing updated software when provided by the software license...retiring a software asset when the software asset is no longer required by the business entity...auditing each software asset owned or licensed by the business entity by prompting a user to respond to at least one question relating to the corresponding software asset uploaded from the server system to the client system for quantifying compliance with the software management process of the business entity.”

None of Conte, Jacobson, or Hedstrom, considered alone or in combination, describe or suggest a method for managing software assets of a business entity as recited in Claim 1. More specifically, none of Conte, Jacobson, or Hedstrom, considered alone or in combination, describe or suggest a method that includes identifying at least one software asset satisfying a predetermined requirement of the business entity, initiating and completing an acquisition process of the at least one software asset satisfying the predetermined business requirement, deploying the acquired software asset, and storing in a centralized database information relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license.

Moreover, none of Conte, Jacobson, or Hedstrom, considered alone or in combination, describe or suggest maintaining software assets licensed by a business entity including reviewing each software license and installing updated software when provided by the software license, and retiring a software asset when the software asset is no longer required by the business entity.

Furthermore, none of Conte, Jacobson, or Hedstrom, considered alone or in combination, describe or suggest auditing software assets owned or licensed by a business entity by prompting a user to respond to at least one question relating to the corresponding software asset uploaded

from a server system to a client system for quantifying compliance with a software management process of the business entity.

Rather, Conte describes a license compliance apparatus for allowing access to a requesting user to a specific application by determining whether a distribution exists which would result in access to the specific application for the requesting user and all current users; Jacobson describes a policy effectiveness system for maintaining security and use policy compliance on a computer network; and Hedstrom describes a statistical tool apparatus for predicting defects in products. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over Conte and Jacobson in view of Hedstrom.

When the recitations of Claims 10 and 35-36 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 10 and 35-36 likewise are patentable over Conte and Jacobson in view of Hedstrom.

The rejection of Claims 18-23 under 35 U.S.C. § 103(a) as being unpatentable over Conte in view of Aycock et al. (U.S. Patent No. 5,765,138) ("Aycock") is respectfully traversed.

Conte is described above. Aycock describes a supplier evaluation system that includes a database storing a plurality of maturity requirements and recognized quality standards, and a main processing system for compiling selected standards and quality maturity requirements in accordance with project objectives. The project requirements are supplied by a communication network to a supplier in the form of an interactive supplier self-evaluation system. The supplier self-evaluation system is arranged to include a plurality of objective questions corresponding to the selected maturity requirements. A supplier may selectively access local database files for information regarding the selected maturity requirements, or may remotely access the supplier evaluation system databases for supplemental information. After uploading the supplier responses to the supplier evaluation system, a supplier maturity level is calculated. An on-site supplier audit is thereafter conducted to confirm supplier responses and to obtain any additional information. Supplier approval is dependent upon a minimum supplier maturity level based upon the scored supplier responses to the maturity questions and the on-site audit.

Claims 18-23 depend from independent Claim 1. Claim 1 recites a method for managing software assets of a business entity using a web-based system including a server system coupled to a centralized database and at least one client system, the business entity having a software management process, wherein the method includes “identifying at least one software asset satisfying a predetermined requirement of the business entity...initiating and completing an acquisition process of the at least one software asset satisfying the predetermined business requirement...deploying the acquired software asset...storing in the centralized database information relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license...maintaining each software asset licensed by the business entity including reviewing each software license and installing updated software when provided by the software license...retiring a software asset when the software asset is no longer required by the business entity...auditing each software asset owned or licensed by the business entity by prompting a user to respond to at least one question relating to the corresponding software asset uploaded from the server system to the client system for quantifying compliance with the software management process of the business entity.”

Neither Conte nor Aycock, considered alone or in combination, describe or suggest a method for managing software assets of a business entity as recited in Claim 1. More specifically, neither Conte nor Aycock, considered alone or in combination, describe or suggest a method that includes identifying at least one software asset satisfying a predetermined requirement of the business entity, initiating and completing an acquisition process of the at least one software asset satisfying the predetermined business requirement, deploying the acquired software asset, and storing in a centralized database information relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license.

Moreover, neither Conte nor Aycock, considered alone or in combination, describe or suggest maintaining software assets licensed by a business entity including reviewing each software license and installing updated software when provided by the software license, and retiring a software asset when the software asset is no longer required by the business entity.

Furthermore, neither Conte nor Aycock, considered alone or in combination, describe or suggest auditing software assets owned or licensed by a business entity by prompting a user to respond to at least one question relating to the corresponding software asset uploaded from a server system to a client system for quantifying compliance with a software management process of the business entity.

Rather, Conte describes a license compliance apparatus for allowing access to a requesting user to a specific application by determining whether a distribution exists which would result in access to the specific application for the requesting user and all current users; and Aycock describes a supplier evaluation system that includes a database for storing a plurality of maturity requirements and recognized quality standards, and a main processing system for compiling selected standards and quality maturity requirements in accordance with project objectives. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over Conte in view of Aycock.

When the recitations of Claims 18-23 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 18-23 likewise are patentable over Conte in view of Aycock.

The rejection of Claims 44-46 under 35 U.S.C. § 103(a) as being unpatentable over Conte is respectfully traversed.

Conte is described above.

Claims 44-46 depend from independent Claim 1. Claim 1 recites a method for managing software assets of a business entity using a web-based system including a server system coupled to a centralized database and at least one client system, the business entity having a software management process, wherein the method includes “identifying at least one software asset satisfying a predetermined requirement of the business entity...initiating and completing an acquisition process of the at least one software asset satisfying the predetermined business requirement...deploying the acquired software asset...storing in the centralized database information relating to each software asset owned or licensed by the business entity including

terms and conditions of each corresponding software license...maintaining each software asset licensed by the business entity including reviewing each software license and installing updated software when provided by the software license...retiring a software asset when the software asset is no longer required by the business entity...auditing each software asset owned or licensed by the business entity by prompting a user to respond to at least one question relating to the corresponding software asset uploaded from the server system to the client system for quantifying compliance with the software management process of the business entity.”

Conte does not describe or suggest a method for managing software assets of a business entity as recited in Claim 1. More specifically, Conte does not describe or suggest a method that includes identifying at least one software asset satisfying a predetermined requirement of the business entity, initiating and completing an acquisition process of the at least one software asset satisfying the predetermined business requirement, deploying the acquired software asset, and storing in a centralized database information relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license.

Moreover, Conte does not describe or suggest maintaining software assets licensed by a business entity including reviewing each software license and installing updated software when provided by the software license, and retiring a software asset when the software asset is no longer required by the business entity.

Furthermore, Conte does not describe or suggest auditing software assets owned or licensed by a business entity by prompting a user to respond to at least one question relating to the corresponding software asset uploaded from a server system to a client system for quantifying compliance with a software management process of the business entity.

Rather, in contrast to the present invention, Conte describes a license compliance apparatus for allowing access to a requesting user to a specific application by determining whether a distribution exists which would result in access to the specific application for the requesting user and all current users. Conte therefore does not describe or suggest a method as recited in Claim 1. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over Conte.

When the recitations of 44-46 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 44-46 likewise are patentable over Conte.

The rejection of Claims 48 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Jacobson in view of Hedstrom is respectfully traversed.

Jacobson and Hedstrom are both described above.

Claim 48 recites a method for tracking software assets owned and licensed by a business entity using a web-based server system coupled to a database and at least one client system, the business entity having a software management process, wherein the method includes “displaying on the client system for a user a software management assessment check list including a series of questions relating to a software asset owned or licensed by the business entity...receiving at the server system responses entered by the user using the client system to each question included within the software management assessment check list...computing a sigma value based on guidelines pre-stored within the database, wherein the sigma value indicates compliance with the software management process of the business entity.”

Neither Jacobson nor Hedstrom, considered alone or in combination, describe or suggest a method for tracking software assets owned and licensed by a business entity as recited in Claim 48. More specifically, neither Jacobson nor Hedstrom, considered alone or in combination, describe or suggest a method that includes displaying on a client system for a user a software management assessment check list including a series of questions relating to a software asset owned or licensed by the business entity, receiving at the server system responses entered by the user using the client system to each question included within the software management assessment check list, and computing a sigma value based on guidelines pre-stored within the database, wherein the sigma value indicates compliance with the software management process of the business entity.

Rather, in contrast to the present invention, Jacobson describes a policy effectiveness system for maintaining security and use policy compliance on a computer network; and Hedstrom describes a statistical tool apparatus for predicting defects in products. Accordingly,

for at least the reasons set forth above, Applicants respectfully submit that Claim 48 is patentable over Jacobson in view of Hedstrom.

Claim 49 recites a method in a web-based system for tracking software assets owned and licensed by a business entity and providing a software management sigma value based on a pre-stored information, the business entity having a software management process, wherein the method includes “receiving at a computer system user input in response to specific questions relating to a software asset owned or licensed by the business entity...analyzing user input against a pre-determined criteria...outputting from the computer system a software management sigma value based on the user input and the pre-determined criteria, wherein the sigma value indicates compliance with the software management process of the business entity.”

Neither Jacobson nor Hedstrom, considered alone or in combination, describe or suggest a method in a web-based system for tracking software assets owned and licensed by a business entity as recited in Claim 49. More specifically, neither Jacobson nor Hedstrom, considered alone or in combination, describe or suggest a method that includes receiving at a computer system user input in response to specific questions relating to a software asset owned or licensed by the business entity, analyzing user input against a pre-determined criteria, and outputting from the computer system a software management sigma value based on the user input and the pre-determined criteria, wherein the sigma value indicates compliance with the software management process of the business entity.

Rather, in contrast to the present invention, Jacobson describes a policy effectiveness system for maintaining security and use policy compliance on a computer network; and Hedstrom describes a statistical tool apparatus for predicting defects in products. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 49 is patentable over Jacobson in view of Hedstrom.

For at least the reasons set forth above, Applicants request that the Section 103 rejection of Claims 48 and 49 be withdrawn.

Additionally, Applicants note that Claim 47 has not been specifically rejected in the Office Action. However, it is shown as being rejected on the Office Action Summary. Accordingly, for the reasons set forth above, Applicants respectfully submit that independent Claim 47 is patentable over the cited art.

In addition to the arguments set forth above, Applicants further submit that the rejection of Claims 7, 9, 13, 26-27, 29-34, 37 and 41 under 35 U.S.C. § 103(a) as being unpatentable over Conte in view of Jacobson; the rejection of Claims 10 and 35-36 under 35 U.S.C. § 103(a) as being unpatentable over Conte and Jacobson in view of Hedstrom; the rejection of Claims 18-23 under 35 U.S.C. § 103(a) as being unpatentable over Conte in view of Aycock; and the rejection of Claims 48-49 under 35 U.S.C. § 103(a) as being unpatentable over Jacobson in view of Hedstrom are further traversed on the grounds that these rejections are not proper rejections.

Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Conte using the teachings of any of Jacobson, Hedstrom or Aycock, or to modify Jacobson in view of Hedstrom. More specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not

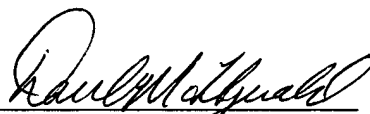
based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

None of Conte, Jacobson, Hedstrom or Aycock, considered alone or in combination, describe or suggest the claimed combination. Rather, these present Section 103 rejections are based on a combination of teachings selected from multiple references in an attempt to arrive at the claimed invention. Since there is no teaching, suggestion or motivation for the combination of Conte, Jacobson, Hedstrom or Aycock, these Section 103 rejections appear to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the rejection of Claims 7, 9, 13, 26-27, 29-34, 37 and 41; the rejection of Claims 10 and 35-36; the rejection of Claims 18-23; and the rejection of Claims 48-49 be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the Section 103 rejections be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in the application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



Daniel M. Fitzgerald
Registration No. 38,880
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070